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# **BEYER WEAVER & THOMAS, LLP**

INTELLECTUAL PROPERTY LAW

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## **FACSIMILE COVER SHEET**

October 20, 2005

**Receiver:** Examiner Christopher P. Schwartz  
Group Art Unit 3683

**TEL #:**

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**Sender:** Alan S. Hodes

**Re:** 10/613,651

**Our File No.:** KASAP037

**Pages Including Cover Sheet(s):** 4

**MESSAGE:**

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OCT 20 2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: HATANO et al.

Attorney Docket No.: KASAP037

Application No.: 10/613,651

Examiner: SCHWARTZ, Christopher P.

Filed: July 2, 2003

Group: 3683

Title: FLUID-FILLED CYLINDRICAL  
VIBRATION DAMPING BUSHING

Confirmation No.: 4615

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being transmitted by facsimile to fax number 571-273-8300 to the U.S. Patent and Trademark Office on October 20, 2005.

Signed: \_\_\_\_\_

*Agnes Spence*  
Agnes Spence

**REQUEST FOR EXAMINER TO CONSIDER REFERENCES FILED  
WITH INFORMATION DISCLOSURE STATEMENT OF  
SEPTEMBER 7, 2005**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the communication from the Examiner dated October 7, 2005 in the above-referenced patent application. In the October 7, 2005 communication, the Examiner cited several alleged deficiencies in the IDS filed on September 7, 2005. The Examiner indicated that, based on the alleged deficiencies, the IDS filed on September 7, 2005 "has been placed in the application file, but the information referred to therein has not been considered."

As discussed in detail below, it is respectfully submitted that the IDS filed September 7, 2005 is fully compliant with the applicable rules and, thus, the references cited therein should be considered by the Examiner and the record of the patent application be updated to contain an indication of such consideration.

**The IDS Contains a Listing of References on a Separate Page**

The Examiner indicates that "The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98." In

pertinent part, the Examiner notes that the applicable rules and regulations require that "the list . . . must be submitted on a separate paper."

Applicant submitted the patent office preferred PTO-1449 as a list "submitted on a separate paper." The PTO-1449 is contained in the PAIR image file wrapper, at page 3 of the 09/07/2005 entry entitled "Information Disclosure Statement (IDS) Filed." In fact, that page is date stamped as "September 07 2005" by the OIPE.

Thus, the listing of references to be considered has been properly provided on a separate page.

The Concise Explanation of the Relevance is Provided in Accordance with the Rules

For some of the non-English references listed on the PTO-1449, English language abstracts have been provided as a concise explanation of the relevance. As clearly stated in MPEP 609.04(a), "Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation."

For some of the non-English references listed on the PTO-1449, an English language abstract was not provided. However, MPEP 609.04(a) provides that "Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office."

In fact, an English-language version of the German office action (from the counterpart German application) was provided. It can be seen that, in the German office action, the Examiner made a detailed application of the references and, thus, clearly indicates the degree of relevance found by the German patent office. The English-language version of the German office action is contained in the PAIR image file, at pages 5-7 of the 09/07/2005 entry entitled "NPL Documents." This document is also cited on the PTO-1449 as Reference "O" and, in addition, is listed in the body of the Information Disclosure Statement as follows:

English abstracts are provided for non-English references, where available. A machine translation is provided for the German Office Action, mailed June 20, 2005 in the corresponding German Patent Application.

Thus, a concise explanation of the relevance of the references has been properly provided.

**REQUEST**

Since the Information Disclosure Statement filed September 7, 2005 is not deficient, Applicant respectfully requests the Examiner to consider the references referred to therein and to indicate such consideration for the record.

Respectfully submitted,  
BEYER WEAVER & THOMAS, LLP



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